

Remarks:

Applicant has carefully studied the Office Action dated December 28, 2004, and has amended the claims to distinctively recite the subject matter of the invention. By virtue of this amendment, all pending claims have been cancelled and new claims 21-30 are added. No new matter has been added. Support for the new claims and the amendments is found within the specification and the drawings. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 103 Rejections:

Claim 21 recites a fishing lure distinct from the cited references, i.e., JP Patent No. 10-262501 (the Japanese reference) and US Patent 5,894,693 (Davie). Neither of the references teach, suggest, or disclose a combination of or a motivation to combine the above claimed elements in the manner recited, as provided in further detail below.

First, it should be noted that using a drawing to reject a claim requires that "the picture must show all the claimed structural features and how they are put together" and "[t]he drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." M.P.E.P. § 2125.

The Applicant has reviewed the translated and Japanese version of the Japanese reference in detail. Referring to FIGS. 1 and 2 of the reference, a fishing lure is disclosed which has a head portion 3 and a tail portion 4. The opposite ends of a memory alloy wire is inserted *deep* into each of the two portions 3 and 4, so that only a small portion (e.g., 5mm) of the entire length of the memory alloy is exposed outside the head and tail portions 3 and 4.

FIG. 2 also shows a substantial length of the wire being inserted into each portion 3 and 4 such that each end of the wire travels the entire length of each portion 3 and 4 all the way to the end. Particularly, the length of the wire inserted into each portion is

greater than the portion exposed outside. Further, FIG. 2 shows the two portions 3 and 4 being hollow.

Also, referring to the specification of the Japanese reference, note translation copy paragraphs 11, 18, 20 of the MEANS, and paragraphs 11, 18 of the DETAILED DESCRIPTION. There it is emphasized that "especially the distance between the body of the 1st lure, and the body of the 2nd lure to have the distance of about 5mm," and that "wire has penetrated the body 3 of head lure, and the body 4 of tail lure over between the head point of the body 3 of head lure, and the tail back end sections of the body 4 of tail lure as shown in drawing 2."

The reason for this emphasis for substantial penetration of the wire into both ends and its limited external exposure is apparently to prevent sliding of the head portion or the tail portion from the wire when a fish bites the lure. Since no connectors are provided to firmly connect each end of the wire to portion 3, 4, the wire can easily become loose and slide out.

Claim 21 recites a structural embodiment patently distinct from the one illustrated in FIGS. 1 and 2 of the Japanese reference. Particularly, the Japanese reference fails to teach first and second connectors attached to first and second terminal ends for preventing separation of the first and second rigid components from the first and second terminal ends or further insertion of the terminal ends into the rigid components.

The Japanese reference further fails to teach or suggest "a substantial length of the shape memory alloy remains exposed outside the first and second rigid components . . . wherein said exposed length is at least greater than length of insertion of at least one of the first terminal end and the second terminal end in the first rigid component and the second rigid component, respectively," as recited in claim 21.

In contrast, the Japanese reference teaches away from the claimed invention by specifically teaching no more than a 5 mm length of wire being exposed between the

head and tail portions. Unlike the Japanese reference, claim 21 recites "a substantial length of the shape memory alloy remains exposed outside the first and second rigid components."

Moreover, the Japanese reference fails to disclose "the flexible housing is formed along the shape memory alloy with a first thickness and around the first and second rigid components with a second thickness, the first thickness being greater than the second thickness."

Referring to the Japanese reference and Davie, both references teach away from "a flexible housing formed substantially proximate to and along the shape memory alloy." That is, the Japanese reference teaches covering each head and tail portion with paint and leaving the 5 mm portion of the wire exposed, so that it can bend freely. Covering the disclosed embodiment even with a flexible material would extensively obstruct the degree by which the wire can bend, due to its short length (i.e., 5 mm). This would frustrate the main objective of the Japanese reference, which is to allow the head and tail of the lure to freely move in relation to one another.

Even further, Davie teaches away from the Japanese reference by requiring the entire length of the flexible wire to be enclosed inside tubular enclosures (e.g., 52, 58, 56, 34, 38, 18). Therefore, it would not have been obvious to one of ordinary skill in the art to combine the two references (see FIGS. 11A and 11B of Davie).

Thus, there would be no motivation for a person of ordinary skill in the art to apply the teachings of Davie to cover the structure disclosed in the Japanese reference. Further, the Examiner has not cited to any portion in either reference that provides a motivation for combining the two references.

It is well settled that there must be some motivation or suggestion to combine, in the prior art references themselves, to come up with the claimed invention. Prior art references in combination do not make an invention obvious unless something in the

prior art references would suggest the advantage to be derived from combining the teachings." In re Sernaker, 217 USPQ 1, 6 (Fed. Cir. 1983).

Since obviousness may not be established by hindsight reconstruction or conjecture, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof pursuant to MPEP §2144.03.²

For the above reasons, the invention as recited in claim 21 is distinguishable over the references cited by the Examiner and should be in condition for allowance. Claims 22-25 are dependent on claim 21 and should also be in condition for allowance by virtue of being dependent on an allowable base claim.

Claim 26 substantially incorporates the elements of claim 21. Therefore, claim 26 and its respective dependent claims 27-30 should be also in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 2100 to discuss the steps necessary for placing the application in condition for allowance.

¹ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Respectfully submitted,

Date: April 28, 2005

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